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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

GATES, ERIC ANDREW

ART UNIT PAPER NUMBER

3722

DATE MAILED: 09/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/749,400	Applicant(s) YOSHIE ET AL.	
	Examiner Eric A. Gates	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-11 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Objections

2. Claims 5 and 6 are objected to because of the following informalities: the claims are written in a manner that does not conform to Standard English.
3. Claims 6 and 11 are objected to because of the following informalities: in line 3 of each of the claims, the word "bookbinding" should be replaced by "bound".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 9 is rejected under 35 U.S.C. 102(b) as being anticipated by Coyette (U.S. Patent 5,632,587).
6. Regarding claim 9, Coyette discloses a pasting and bookbinding apparatus comprising: (a) a sheet bundle loading device 16 for stacking sheets ejected from an

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image forming apparatus 10; (b) a sheet bundle transporting device 20 having a holding device 64/66 for transporting a sheet bundle F composed of plural sheets stacked on the sheet bundle loading device 16 and holding the sheet bundle to be erected at a prescribed position (see figure 2); and (c) a paste coating device 76 having a movable paste coating member 80 for coating paste on end surfaces of superposed sheet bundles held at the prescribed position (see figure 5), wherein the paste coating member 80 stands by at an initial position outside an area for a maximum-sized sheet, and moves along the end surfaces of superposed sheet bundle held in the erected state to coat paste 82 when a paste coating processing is carried out.

7. Claims 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Coyette (U.S. Patent 5,632,587).

8. Regarding claim 10, Coyette discloses a pasting and bookbinding apparatus comprising: (a) a sheet bundle loading device 16 on which sheets ejected from an image forming apparatus 10 are stacked; (b) a sheet bundle transporting device 20 having a holding device 64/66 for transporting a sheet bundle F composed of plural sheets stacked on the sheet bundle loading device and holding the sheet bundle to be erected at a prescribed position; (c) a paste coating device 76 that stands by at an initial position outside an area in a lateral direction in a direction of end surfaces of a superposed maximum-sized sheet bundle (see figure 1), and moves along end faces of the superposed sheet bundle held in the erected state, when a paste coating processing is carried out; (d) a cover supplying device (not shown, see column 5, lines 30-33 and

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40-41) that contains cover sheets which touch the surface and the back of the sheet bundle and supplies; (e) a cover pasting device (not shown, see column 5, lines 34-37 and 40-41) for bringing a cover sheet to be in pressure contact with end surfaces of superposed sheet bundle which has been subjected to paste coating processing to paste the cover sheet; and (f) a cover folding device (not shown, see column 1, lines 21-28, and column 5, lines 40-41) for folding a cover sheet pasted on the sheet bundle by the cover pasting device along the end faces of superposed sheet bundle.

9. Regarding claim 11, Coyette discloses wherein a booklet formed by the cover folding device is "bound" by wrapping the sheet bundle with a front cover surface, a back cover surface and the end faces of the superposed sheet bundle (these limitations are inherent to the process of applying a pre-formed cover to a sheet bundle).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, 3, 5, 6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coyette.

12. Regarding claim 1, Coyette discloses a pasting and bookbinding apparatus: (a) a sheet bundle loading device 16 for positioning sheets ejected from an image forming apparatus 10 and stacking the positioned sheets thereon; (b) a holding device 18 for

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holding a sheet bundle F stacked on the bundle of sheets loading device 16 and transporting; (c) a sheet bundle transporting device 20 for receiving the sheet bundle transported by the holding device 18 and interposing the sheet bundle to erect (see figure 2); (d) a paste coating device 76 for coating paste on a back of the sheet bundle interposed and erected by the sheet bundle transporting device 20; (e) a cover supplying device (not shown, see column 5, lines 30-33 and 40-41) for supplying a cover sheet; (f) a cover pasting device (not shown, see column 5, lines 34-37 and 40-41) for pressing the cover sheet supplied from the cover supplying device against a paste-coated back of the sheet bundle to paste; and (g) a cover folding device (not shown, see column 1, lines 21-28, and column 5, lines 40-41) for folding the cover sheet pasted on a sheet bundle by the cover pasting device along an edge portion of a paste-coated surface of the sheet bundle.

Coyette does not disclose wherein elements (a) to (g) are arranged in a longitudinal line in a vertical direction inside a main body of the pasting and bookbinding apparatus. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have formed the binding stations of Coyette in a longitudinal line in a vertical direction instead of horizontally and including a 90 degree turn in the middle of the machine for the purpose of having a design that is convenient for the binding location, since it has been held that rearranging parts of an invention involves only routine skill in the art.

13. Regarding claim 3, the modified invention of Coyette discloses the invention substantially as claimed, except Coyette does not distinctly disclose further comprising

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an elevating device provided in a lower portion of the pasting and bookbinding apparatus, for moving the cover pasting device and the cover folding device in a vertical direction. However, the Examiner takes Official Notice that it is well known in the art and would have been an obvious variant to have used an elevation device provided in a lower portion of the pasting and bookbinding apparatus for moving the cover pasting device in a vertical direction, for the purpose of raising the paste coating member to the sheet bundle to apply glue, and for the purpose of raising the cover folding device to the assembled booklet for the purpose of folding the cover over the sheet bundle, because either the cover pasting and cover folding devices would have to be raised or the sheet bundle would have to be lowered to perform these operations in the modified invention of claim 1.

14. Regarding claim 5, the modified invention of Coyette discloses wherein formation of a sheet bundle F by sticking between sheets with paste and bookbinding by wrapping with a cover by which a booklet is made by sticking a cover composed of a front cover and a back cover to a sheet bundle with paste (all of these limitations are disclosed in claim 1 or are inherent to the binding operation), carried out at a same location (the location of the bookbinding apparatus).

15. Regarding claim 6, the modified invention of Coyette discloses wherein a booklet formed by the cover folding device is "bound" by wrapping the sheet bundle F with a front cover surface, a back cover surface and a back of the sheet bundle in which the paste applied portion back of the sheet bundle is pasted ((all of these limitations are disclosed in claim 1 or are inherent to the binding operation).

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16. Regarding claim 8, the modified invention of Coyette discloses an image forming system 10 comprising: (a) an image forming apparatus main body including an image writing means, an image forming means and a sheet transporting means (all of these limitations are inherent to a standard copy machine as disclosed in column 1, lines 5-9); and (b) the pasting and bookbinding apparatus described in the claim 1.

17. Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coyette in view of Delfer et al. (U.S. Patent 5,754,434).

18. Regarding claim 2, the modified invention of Coyette discloses the invention substantially as claimed, except Coyette does not disclose further comprising a sheet ejection device arranged in an upper portion of a main body of the pasting and bookbinding apparatus, for directly ejecting a sheet which does not need to be subjected to pasting and bookbinding processing.

Delfer et al. teaches the use of a sheet ejection device (incorporated into region 105, see column 17, lines 54-56) used for the purpose of eliminating any non-desired pages. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the binding apparatus of Coyette with the sheet ejection device of Delfer et al. in order to have a binding apparatus that can discard sheets that are not appropriate for binding.

19. Regarding claim 4, the modified invention of Coyette discloses a transporting device 20 that is composed of a sheet transport path (see figure 1) through which a sheet ejected from the image forming apparatus 10 is transported and is fed into the

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sheet bundle loading device 16, a cover transport path (not shown but inherent) through which a sheet for a cover supplied from the cover supplying device is transported to the cover pasting device and a sheet ejection path (not shown but inherent) through which a sheet is transported to the sheet ejection device.

Allowable Subject Matter

20. Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric A. Gates whose telephone number is 571-272-5498. The examiner can normally be reached on Monday-Thursday 7:45-6:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



EAG
28 August 2006



MONICA CARTER
SUPERVISORY PATENT EXAMINER